

ESTTA Tracking number: **ESTTA965778**

Filing date: **04/09/2019**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92066968
Party	Defendant Software Freedom Conservancy
Correspondence Address	PAMELA S CHESTEK CHESTEK LEGAL P O BOX 2492 RALEIGH, NC 27602 UNITED STATES pamela@chesteklegal.com 919-800-8033
Submission	Motion to Amend/Amended Answer or Counterclaim
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Date	04/09/2019
Attachments	Motion to Amend to Add Counterclaim.pdf(571149 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 4212971
Mark: SOFTWARE FREEDOM CONSERVANCY
Registration date: September 25, 2012

Software Freedom Law Center

Petitioner,

v.

Software Freedom Conservancy, Inc.

Registrant.

Cancellation No. 92066968

REGISTRANT'S MOTION TO AMEND ITS ANSWER TO ADD A COUNTERCLAIM

Pursuant to Rule 15(a), Fed. R. Civ. P. and Trademark Rule 2.115, Registrant Software Freedom Conservancy, Inc. ("Conservancy") moves the Trademark Trial and Appeal Board ("Board") for leave to amend its Amended Answer¹ to add a counterclaim. Exhibit A, attached hereto, is a copy of the proposed Amended Answer and Counterclaim.² In its proposed counterclaim, Registrant seeks cancellation of Petitioner Software Freedom Law Center, Inc.'s ("SFLC") U.S. Registration No. 3,913,979 for the mark SOFTWARE FREEDOM LAW CENTER, a registration upon which Petitioner relies as a basis for the instant

¹ The Amended Answer, 14 TTAB 11-15, is the current operative answer. *See* 19 TTABUE 10-11.

² The proposed Amended Answer and Counterclaim also omits one affirmative defense that the Board struck in its ruling granting the motion to amend the Answer. *See* 19 TTABUE 11 ("The Board sua sponte strikes the putative 'affirmative defense' of failure to state a claim upon which relief can be granted."). Exhibit B is a clean, signed copy of the Amended Answer and Counterclaim.

proceeding seeking cancellation of Conservancy's registration for SOFTWARE FREEDOM CONSERVANCY. The counterclaim alleges that the registration for the mark SOFTWARE FREEDOM LAW CENTER is invalid because the mark is generic.

For the reasons set forth below, Registrant asks that the Board grant this motion.

ARGUMENT

Fed. R. Civ. P. 15(a), made applicable to inter partes proceedings by Trademark Rule 2.116(a), encourages the Board to look favorably on motions to amend pleadings, stating that "the court should freely give leave when justice so requires." In general, the Board will give leave to amend "unless there has been undue delay that would prejudice the nonmoving party, the moving party has acted in bad faith, or the amendment would be futile." *Jive Software, Inc. v. Jive Commc'ns, Inc.*, 125 U.S.P.Q.2d 1175, 1177 (TTAB 2017).

A. Because of the Unusual Procedural Posture of the
Cancellation, There has Been No Undue Delay by Registrant in
Bringing its Counterclaims

SFLC filed a petition to cancel the Registrant's trademark registration one working day shy of the five year anniversary of that registration. SFLC filed the petition against an entity it had formed and named and with which it co-existed for over 10 years. These facts, as well as other facts as explained in much more detail in other filings in this proceeding, led to the obvious affirmative defenses of laches, acquiescence and equitable estoppel. Conservancy therefore filed an early Motion for Summary

Judgment.³ The motion was initially denied on the basis that Conservancy had not adequately pleaded the defenses in its original Answer.⁴ There was further motion practice on a failed effort by SFLC to amend its petition,⁵ after which Conservancy successfully amended its Answer⁶ and quickly filed the Motion for Summary Judgment again.⁷ Rather than opposing the motion, SFLC filed a motion seeking additional discovery.⁸ In response, on January 15, 2019 the Board took the unusual step of mooted the discovery motion and denying the Motion for Summary Judgment without any responsive brief having been filed.⁹ A few days later, on January 21, 2019, Conservancy filed a Request for Reconsideration,¹⁰ which is now fully briefed.¹¹ Because the Board did not suspend the proceeding in response to the Request for Reconsideration, on March 6, 2019 Conservancy filed a Motion to Suspend pending disposition of the Request for Reconsideration;¹² however, the Board has not yet suspended the proceedings.

³ 6 TTABVUE.

⁴ 8 TTABVUE.

⁵ 9 TTABVUE, 13 TTABVUE (incorrectly stating “D MOT DENIIED [sic],” it was Petitioner’s motion that was denied).

⁶ 19 TTABVUE.

⁷ 20 TTABVUE.

⁸ 24 TTABVUE.

⁹ 28 TTABVUE.

¹⁰ 29 TTABVUE.

¹¹ 30 TTABVUE; 31 TTABUE.

¹² 32 TTABVUE. The motion was opposed at 33 TTABVUE.

Although this action was filed on September 22, 2017, it is still in its early stages. The schedule has been reset twice,¹³ each time starting with the deadline for initial disclosures.¹⁴ Even without granting Conservancy's Motion to Suspend while the Board considers the Request for Reconsideration, as it currently stands discovery does not close until July 13, 2019.¹⁵

Conservancy had hoped that the matter could be resolved on its early Motion for Summary Judgment. The motion was based solely on equitable defenses, so it was not necessary to reach the validity of the SFLC registration in order to have a final resolution of the case. Conservancy therefore elected not to multiply or expand this proceeding by filing a counterclaim challenging the validity of the SFLC registration with its initial Answer, believing that the proceeding could have a final disposition upon a favorable outcome on the Motion for Summary Judgment. However, because the Board has denied the Motion for Summary Judgment and the proceedings have not been stayed while it is being reconsidered, Conservancy is compelled at this time to ask the Board for leave to amend the Answer to state a counterclaim for cancellation of the asserted registration while there is still adequate time for discovery, thus avoiding undue delay.

¹³ 13 TTABVUE; 28 TTABVUE.

¹⁴ 13 TTABVUE 8; 28 TTABVUE 5.

¹⁵ 28 TTABVUE 5.

B. Petitioner Will Not Be Prejudiced If Registrant is Allowed to Amend its Pleadings Because this Proceeding is In Its Early Stages

Petitioner will not be prejudiced by Registrant's proposed amendment because, as described above, this proceeding is still in its initial stages. Neither party has yet conducted any depositions and the discovery period is still open for more than three months. Thus, Petitioner will not be prejudiced as it will have the full and complete opportunity to investigate and conduct discovery on Registrant's counterclaim. In fact, the Board has allowed amendments to pleadings at much later stages than that requested by Registrant. *See, e.g., Focus 21 Int'l Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992)(granting the motion to add a defense of abandonment filed prior to opening of petitioner's testimony period; it would not cause undue prejudice because the discovery period could be reopened).

C. Registrant Did not Have Bad Faith or Dilatory Motive And the Amendment Is Not Futile

By bringing its proposed counterclaim at this stage, there is no bad faith or dilatory motive on the part of the Registrant. As previously noted, the Registrant tried to avoid complicating the proceedings with a counterclaim when the counterclaim was not germane to the defense being asserted in an early Motion for Summary Judgment—in other words, the Registrant was acting in good faith, trying to avoid expending both parties' charitable resources unnecessarily. The Registrant continues to act in good faith by moving to amend the Answer while it is still early in the proceedings so that undue prejudice can be avoided.

Additionally, the proposed counterclaim is not futile. The counterclaim alleges that the mark SOFTWARE FREEDOM LAW CENTER is generic. A challenge that a trademark is generic can be brought at any time. Trademark Act of 1956 § 14(3), 15 U.S.C. § 1064(3) (2012). The petition for cancellation is premised on the claim that SFLC has trademark rights in SOFTWARE FREEDOM LAW CENTER. If the mark is instead generic, then the petition to cancel will be dismissed.

D. Justice Requires Allowing the Counterclaim

The Board has acknowledged that a motion to amend to add a compulsory counterclaim is cause for greater – not less – leniency in granting leave to amend. *Jive Software, Inc. v. Jive Commc'ns, Inc.*, 125 U.S.P.Q.2d 1175 (T.T.A.B. 2017), citing 6 Charles Alan Wright, et al., FEDERAL PRACTICE & PROCEDURE § 1430 (3d ed. April 2017)). A validity challenge is also to be encouraged because it is in the public interest: “if a plaintiff’s registration is invalid, it is to the benefit of the public as well as to the defendant to have it promptly removed from the register.” *Id.* This is doubly true where the challenge to the validity of the pleaded registration is that the mark is generic. *See, e.g., Delaware Quarries, Inc. v. Playcore IP Sub, Inc.*, 108 U.S.P.Q.2d 1331 (T.T.A.B. 2013) (noting that the public has an interest in ridding the register of generic marks).

Newly learned facts in this case demonstrate that there is also public interest in the counterclaim. In an email sent on March 28, 2019, a settlement offer from SFLC demanded that, in order for SFLC to settle the case, the following must occur:

- SFC [Conservancy] must agree to cancellation of U.S. Trademark Registration No. 4212971;
- SFC must agree never to use or seek registration of any mark that incorporates a SOFTWARE FREEDOM component for any good or service;

- SFC must agree to discontinue all uses of SOFTWARE FREEDOM CONSERVANCY within 60 days of execution of an agreement;
- SFC must agree not to challenge and/or contest the validity of SFLC's trademark registrations that incorporate the terms SOFTWARE FREEDOM;
- SFC must agree to discontinue all uses of SOFTWARE FREEDOM CONSERVANCY within 60 days of execution of an agreement;
- SFC must agree to rename itself so that the word FREEDOM is not featured in their corporate name within 60 days of execution of an agreement;
- SFC must agree to discontinue use of sfconservancy.org and softwarefreedomconservancy.org within 60 days of execution of an agreement; and
- SFLC and SFC will agree to a mutual non-disparagement provision.

See Exhibit C.¹⁶

The import of this communication is that Petitioner is claiming to have exclusive rights in the term “software freedom,” to wit, “SFC must agree never to use or seek registration of any mark that incorporates a SOFTWARE FREEDOM component for any good or service” and “SFC must agree not to challenge and/or contest the validity of SFLC's trademark registrations that incorporate the terms SOFTWARE FREEDOM” (not SOFTWARE FREEDOM LAW CENTER, but SOFTWARE FREEDOM per se). SFLC is taking the position that it has exclusive rights in the generic term “software freedom,” a term in common use by the public. Justice therefore requires that Conservancy have the opportunity to defend a generic term not only on its own behalf, but also for the software community at large.

¹⁶ The communication is not being submitted to prove or disprove the validity or amount of SFLC's claim or to impeach by a prior inconsistent statement or a contradiction. See Fed. R. Civ. P. 408. Rather, the exhibit is being submitted to show that Conservancy only just became aware that SFLC is claiming exclusive rights in the phrase “software freedom.”

Registrant respectfully submits that, for the foregoing reasons, there has not been any undue delay by Registrant in bringing this motion to amend. The parties will not be prejudiced because the case is still in the discovery period. The Registrant's election not to file a counterclaim in its initial answer was to reduce the burden on the Board, not for purposes of delay. The amendment will not be futile because a successful counterclaim will dispose of the entire proceeding. Finally, justice requires that the counterclaim be allowed in the public interest.

CONCLUSION

Based upon the above facts and law, Registrant respectfully requests that the Board grant its motion to amend and add a counterclaim to challenge the registrability of Petitioner's U.S. Registration No. 3,913,979 for the mark SOFTWARE FREEDOM LAW CENTER.

Respectfully submitted,

Dated: April 9, 2019

By: 

Pamela S. Chestek
Chestek Legal
PO Box 2492
Raleigh, NC 27602
Attorney for Registrant
pamela@chesteklegal.com

Certificate of Service

I hereby certify that a true and complete copy of the foregoing REGISTRANT'S MOTION TO AMEND THE ANSWER TO ADD A COUNTERCLAIM has been served on Software Freedom Law Center on April 9, 2019 by emailing a copy thereof to Petitioner's counsel at mishi@softwarefreedom.org and smcmahon@ostrolenk.com.

Mishi Choudhary
Software Freedom Law Center
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New York, NY 10025

Sean P. McMahon
Ostrolenk Faber LLP
845 Third Avenue, 8th Floor
New York, NY 10022

By: 
Pamela S. Chestek

Exhibit A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 4212971
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Registration date: September 25, 2012

Software Freedom Law Center

Petitioner,

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Registrant.

Cancellation No. 92066968

AMENDED ANSWER AND COUNTERCLAIM

Registrant Software Freedom Conservancy, by its counsel, responds as follow to the Petition to Cancel:

1. Registrant lacks knowledge and information sufficient to form a belief as to the allegations of Paragraph 1 of the Petition to Cancel and therefore denies the same.
2. No response required. The registration speaks for itself.
3. Registrant lacks knowledge and information sufficient to form a belief as to the allegations of Paragraph 3 of the Petition to Cancel and therefore denies the same.
4. Denied.
5. Denied.
6. Denied.
7. Admitted.
8. Registrant lacks knowledge and information sufficient to form a belief as to the allegations of Paragraph 8 of the Petition to Cancel and therefore denies the same.
9. Admitted.

10. Admitted, except that the Registrant's certificate of incorporation was filed on March 20, 2006 and was accepted and sealed by the New York Department of State on April 7, 2006.
11. Admitted.
12. Admitted.
13. Admitted.
14. Admitted, except that Mr. Kuhn became Executive Director on October 1, 2010.
15. Admitted.
16. Admitted.
17. No response is required. There is no allegation in Paragraph 17.
18. Denied.
19. Registrant lacks knowledge and information sufficient to form a belief as to the allegations of Paragraph 19 of the Petition to Cancel and therefore denies the same.
20. Denied.
21. Denied.
22. Registrant lacks knowledge and information sufficient to form a belief as to the allegations of Paragraph 22 of the Petition to Cancel and therefore denies the same.
23. Denied.
24. Denied.
25. Admitted.
26. Admitted.
27. Admitted.
28. Admitted.
29. Admitted.
30. Admitted.

31. Admitted.

32. Admitted, except that the statement was made by the signatory, not the Registrant.

AFFIRMATIVE DEFENSES

~~1. The Petition for Cancellation fails to state a claim upon which relief can be granted.~~

2. Petitioner created Registrant in 2006, chose its name, provided legal services to Registrant for many years, and routinely interacted with Registrant from its inception until the present. At no time between the publication of Registrant's trademark on July 10, 2012 and the date of the Petition for Cancellation, November 22, 2017, did Petitioner object to Registrant's registration of SOFTWARE FREEDOM CONSERVANCY. Registrant changed its economic position during that period by expending significant resources to expand its trade and accrue significant goodwill in the mark. Petitioner's claim is therefore barred by the doctrine of laches.

3. Petitioner has affirmatively promoted and encouraged Registrant's activities from its inception until the present, including inviting Registrant's personnel to speak at its events. As recently as May, 2016 the Executive Director of Petitioner stated expressly that he had no complaints against Registrant. Petitioner's claim is therefore barred by the doctrine of acquiescence.

4. At no time between the publication of the Registrant's trademark on July 10, 2012 and the date of the Petition for Cancellation, November 22, 2017, did Petitioner object to Registrant's registration of SOFTWARE FREEDOM CONSERVANCY. Registrant relied on Petitioner's silence as indicating that Petitioner did not object to Registrant's use and registration of its mark. Registrant changed its economic position during that period by expending significant resources to expand its trade and accrue significant goodwill in the mark. Petitioner's claim is therefore barred by the doctrine of equitable estoppel.

5. The Executive Director of Petitioner affirmatively stated in May, 2016 that he had no complaints against Registrant, only its employees. He subsequently stated on or about November 22, 2017, after the petition to cancel was filed, that he expects the Registrant to be able to continue to use its mark. Therefore, the Petition to Cancel was not filed because of any trademark concern, but as a misuse of legal process to harass individuals for unrelated perceived wrongs. Petitioner's claim is therefore barred by the doctrine of unclean hands.

6. Registrant is a former client of Petitioner. The same lawyers at Petitioner who represented Registrant are now acting as lawyers for Petitioner, adverse to Registrant in a matter substantially

related to the work the Petitioner performed for Registrant, namely, the formation and naming of Registrant. Petitioner's claim is therefore barred by the doctrine of unclean hands.

COUNTERCLAIM FOR CANCELLATION OF REGISTRATION NO. 3,913,979

Software Freedom Conservancy, Inc. ("Conservancy"), a 501(c)(3) tax exempt not-for-profit charity, believes that it has been and will continue to be damaged by U.S. Trademark Registration No.3,913,979 for the mark SOFTWARE FREEDOM LAW CENTER, and hereby petitions to cancel the same pursuant to § 14(3) of the Trademark Act of 1946, 15 U.S.C. § 1064(3).

As grounds for cancellation, Petitioner in Counterclaim alleges as follows:

1. Conservancy is a nonprofit organization, providing administrative, legal and management support for Conservancy members' free and open source software (FOSS) projects, to help them better devote their resources to software development and documentation.
2. Software Freedom Law Center, Inc. ("SFLC") is the owner of U.S. Reg. No. 3,913,979 for SOFTWARE FREEDOM LAW CENTER, which issued on February 1, 2011 in Class 45 for "legal services" (the "'979 Registration").
3. SFLC has asserted the '979 Registration in the instant Petition to Cancel Conservancy's U.S. Reg. No. 4,212,971 for SOFTWARE FREEDOM CONSERVANCY on the ground that the Conservancy service mark was likely to be confused with the mark of the '979 Registration.
4. The genus of the services in the '979 Registration is, as stated in the registration, "legal services."
5. "Free software" and "open source software" are terms used to describe software licensed on terms that give the software users certain user rights, sometimes referred to as the "Four Freedoms." The terms "free software" and "open source software" are used separately and also commonly combined into the term "free and open source software."
6. The SFLC states on its webpage that "its mission [is] to provide pro bono legal services to Free and Open Source Software projects"
7. The actual and potential consumers of SFLC's services are those who are seeking legal services relating to FOSS projects.

8. “Free software” and “software freedom” are synonymous, that is, “free software” is the concrete noun form and “software freedom” is the same concept expressed as an abstract noun.
9. The Wikipedia page for “software freedom” redirects to a page titled “Free software movement.”
10. “Software freedom” is widely used in ordinary speech to refer to free software.
11. The Free Software Foundation, a 503(c)(3) nonprofit for which SFLC formerly provided legal services, states on every page that it is “a charity with a worldwide mission to advance **software freedom**.”
12. The Open Source Initiative, a California public benefit corporation with 501(c)(3) tax-exempt status, states on its home page “the OSI champions **software freedom** in society through education, collaboration, and infrastructure, stewarding the Open Source Definition (OSD), and preventing abuse of the ideals and ethos inherent to the open source movement **Software freedom** is essential to enabling community development of open source software.”
13. On information and belief, SFLC has not challenged use of the term “software freedom” by the entities known as “Software Freedom Day,” “Software Freedom School” or “Software Freedom Kosova” as part of their names.
14. SFLC itself uses the term “software freedom” as a noun identifying what free software licenses provide.
15. A job posting by SFLC stated “In addition, the Attorney will be expected to publish writing and make public presentations on topics related to **software freedom**.”
16. SFLC-authored conference materials state “As we begin our second decade of working as counselors and advocates for **software freedom** ...”
17. SFLC’s website page for its SFLC Internship Program states “Applicants should have a demonstrated interest in **software freedom** and be conversant in legal and technical concepts related to free and open source software.”
18. SFLC’s website page for “Technology” states “the Software Freedom Law Center also tries to produce useful technology that allows non-profit organizations and law centers to operate in **software freedom**.”

19. A well-regarded 2008 publication by the SFLC, “A Legal Issues Primer for Open Source and Free Software Projects,” states:

- “[W]e present a starting point for lawyers and risk managers for thinking about the particular, at times counter-intuitive, logic of *software freedom*.”
- “Some copyleft advocates regard the AGPL as the next logical step toward *software freedom*.”
- “The default trademark rules are sufficient for most *Software Freedom* projects.”

20. In its Petition to Cancel, SFLC characterized its mark SOFTWARE FREEDOM LAW CENTER as containing the “element 'Software Freedom' at the beginning of the mark, followed by a ... compound noun.”

21. “Law Center” is the compound noun to which SFLC was referring.

22. “Law Center” is a generic term.

23. Combining the generic term “software freedom” with “law center” provides no additional or changed meaning. The term as a whole identifies a subclass of legal services provided to those who work in the field of software freedom.

24. The term “software freedom law center” is generic for legal services and therefore Registration No. 3,913,979 is invalid.

WHEREFORE, Applicant prays that Registration No. 3,913,979 be cancelled, that the Petition to Cancel be dismissed, and that judgment be entered in favor of Registrant against Petitioner.

Respectfully submitted,

By: _____

Pamela S. Chestek

Chestek Legal

PO Box 2492

Raleigh, NC 27602

Attorney for Registrant

pamela@chesteklegal.com

Certificate of Service

I hereby certify that a true and complete copy of the foregoing Amended Answer and
Counterclaim has been served on Software Freedom Law Center on April 9, 2019~~April 4, 2019~~
by emailing a copy thereof to Petitioner's counsel at mishi@softwarefreedom.org and
smcmahon@ostrolenk.com, ~~via electronic mail to: April 27, 2018~~~~mailing said copy on~~.

Mishi Choudhary~~Daniel Byrnes~~
Software Freedom Law Center
~~435 West 116th Street~~
PO Box 250874
New York, NY 1002~~57~~
~~Email: dbyrnes@softwarefreedom.org~~

Sean P. McMahon
Ostrolenk Faber LLP
845 Third Avenue, 8th Floor
New York, NY 10022

By: _____
Pamela S. Chestek

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18. SFLC’s website page for “Technology” states “the Software Freedom Law Center also tries to produce useful technology that allows non-profit organizations and law centers to operate in ***software freedom.***”

19. A well-regarded 2008 publication by the SFLC, “A Legal Issues Primer for Open Source and Free Software Projects,” states:
- “[W]e present a starting point for lawyers and risk managers for thinking about the particular, at times counter-intuitive, logic of *software freedom*.”
 - “Some copyleft advocates regard the AGPL as the next logical step toward *software freedom*.”
 - “The default trademark rules are sufficient for most *Software Freedom* projects.”
20. In its Petition to Cancel, SFLC characterized its mark SOFTWARE FREEDOM LAW CENTER as containing the “element 'Software Freedom' at the beginning of the mark, followed by a ... compound noun.”
21. “Law Center” is the compound noun to which SFLC was referring.
22. “Law Center” is a generic term.
23. Combining the generic term “software freedom” with “law center” provides no additional or changed meaning. The term as a whole identifies a subclass of legal services provided to those who work in the field of software freedom.
24. The term “software freedom law center” is generic for legal services and therefore Registration No. 3,913,979 is invalid.

WHEREFORE, Applicant prays that Registration No. 3,913,979 be cancelled, that the Petition to Cancel be dismissed, and that judgment be entered in favor of Registrant against Petitioner.

Respectfully submitted,

By: 

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Certificate of Service

I hereby certify that a true and complete copy of the foregoing Amended Answer and Counterclaim has been served on Software Freedom Law Center on April 9, 2019 by emailing a copy thereof to Petitioner's counsel at mishi@softwarefreedom.org and smcmahon@ostrolenk.com.

Mishi Choudhary
Software Freedom Law Center

PO Box 250874
New York, NY 10025

Sean P. McMahon
Ostrolenk Faber LLP
845 Third Avenue, 8th Floor
New York, NY 10022

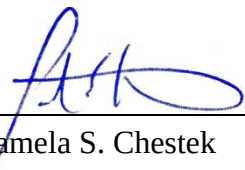
By:  _____
Pamela S. Chestek

Exhibit C

Subject: Software Freedom Law Center v. Software Freedom Conservancy - TTAB Cancellation No. 92066968 - OF Ref.: 7E/6642-2
From: Sean McMahon <smcmahon@ostrolenk.com>
Date: 3/28/2019, 5:50 PM
To: Pamela Chestek <pamela@chesteklegal.com>
CC: "John L. Welch" <John.Welch@WolfGreenfield.com>, Shannon Falloon <sfalloon@ostrolenk.com>

*****FOR SETTLEMENT PURPOSES ONLY*****
*****SUBJECT TO FRE 408*****

Dear Pam:

In November we discussed a possible settlement proposal concerning this cancellation proceeding. SFLC has now authorized me to propose the following core settlement terms to bring about an amicable resolution of this matter:

- SFC must agree to cancellation of U.S. Trademark Registration No. 4212971;
- SFC must agree never to use or seek registration of any mark that incorporates a SOFTWARE FREEDOM component for any good or service;
- SFC must agree to discontinue all uses of SOFTWARE FREEDOM CONSERVANCY within 60 days of execution of an agreement;
- SFC must agree not to challenge and/or contest the validity of SFLC's trademark registrations that incorporate the terms SOFTWARE FREEDOM;
- SFC must agree to discontinue all uses of SOFTWARE FREEDOM CONSERVANCY within 60 days of execution of an agreement;
- SFC must agree to rename itself so that the word FREEDOM is not featured in their corporate name within 60 days of execution of an agreement;
- SFC must agree to discontinue use of sfconservancy.org and softwarefreedomconservancy.org within 60 days of execution of an agreement; and
- SFLC and SFC will agree to a mutual non-disparagement provision.

If the foregoing terms are acceptable, please advise. I will then prepare a suitable agreement.

Sincerely yours,

Sean P. McMahon

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